

ADMINISTRATIVE PANEL DECISION

American Medical Software v. Belize Domain WHOIS Service Lt Case No. D2010-1004

1. The Parties

The Complainant is American Medical Software of Edwardsville, Illinois, United States of America, represented by Husch Blackwell Sanders Welsh & Katz, United States of America.

The Respondent is Belize Domain WHOIS Service Lt, Belize, Wisconsin, United States of America.

2. The Domain Name and Registrar

The disputed domain name <americanmedicalsoftware.com> is registered with Intercosmos Media Group d/b/a directNIC.com (the "Registrar").

3. Procedural History

The Complaint was brought pursuant to the Uniform Domain Name Dispute Resolution Policy (the "Policy" or "UDRP"), which was adopted by the Internet Corporation for Assigned Names and Numbers ("ICANN") on August 26, 1999, and approved on October 24, 1999, and also in accordance with the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules") as approved on October 24, 1999, and the World Intellectual Property Organization ("WIPO") Supplemental Rules for Uniform Domain Name Dispute Resolution Policy in effect as of December 14, 2009 (the "Supplemental Rules").

The Complaint, with accompanying Annexes A-I (with sub-annexes), was filed with the WIPO Arbitration and Mediation Center (the "Center") by email on June 17, 2010.

Pursuant to paragraph 4(d) of the Policy, the Complainant selected the Center as the ICANN approved administrative dispute resolution service provider to administer this proceeding. Through the Complaint, the Complainant requested a single-member panel.

After receiving the Complaint, the Center, in accordance with paragraph 5 of the Supplemental Rules, verified that the original Complaint complied with the formal requirements of the Rules and the Supplemental Rules. In that regard, on June 18, 2010, the Center requested confirmation from the Registrar as to: whether the Registrar received a copy of the Complaint from the Complainant, contact and registrant information set forth in that Complaint relative to the disputed domain name, and whether the disputed domain name is indeed registered with the Registrar. The Center also requested the Registrar to specify for the disputed domain name: (a) the dates on which the registrant registered the disputed domain name (or

acquired the registration) and when the registration will expire, (b) whether the Policy applies to that disputed domain name, (c) the language of the registration agreement, and (d) for confirmation that this disputed domain name will remain "locked" during the proceeding.

Subsequently, on June 18, 2010, the Registrar provided its response to the Center through which it confirmed it is the registrar for the name, and specified name and contact information pertinent to the disputed domain name to the extent, as it then existed, in its WhoIS database. Further, the Registrar stated that it had received a copy of the Complaint. The Registrar's response further indicated that: (a) the registration for the name was created on April 2, 2006 and will expire on April 2, 2011, (b) the Policy applies to the disputed domain name, (c) the registration agreement for the disputed domain name is in English, and (d) the disputed domain name will remain locked during the proceeding.

The Center verified that the Complaint satisfied the formal requirements of the Policy, the Rules and the Supplemental Rules.

On July 6, 2010, the Center formally notified the Respondent of the filing of the Complaint, including an indication that the Center was forwarding a complete copy of the Complaint to the Respondent, together with all its annexes, by email. The Complaint and its accompanying documents, and all subsequent communications associated therewith, were provided in the preferred manners and to the addresses as mandated by paragraphs 2(a), 2(b) and 4(a) of the Rules.

Hence, the notification to the Respondent having occurred on July 6, 2010, under paragraph 4(c) of the Rules, this administrative proceeding is deemed to have commenced on that date.

Having reviewed the Complaint and all the correspondence, including that between the Center and the Registrar, the Panel agrees with the determination of the Center that the Complaint and its handling met the requirements of the Rules and the Supplemental Rules.

The Respondent was then provided with a 20 calendar day period, expiring on July 26, 2010, to file its Response with the Center and the Complainant.

As of July 26, 2010, the Center had not received a formal Response to the Complaint from the Respondent. Hence, the Center, in an email letter dated July 27, 2010, notified the Respondent of his default.

Pursuant to the Rules and Supplemental Rules, by email letter dated August 4, 2010, the Center contacted the undersigned, Mr. Peter L. Michaelson, Esq., requesting his service as the sole panelist for this dispute. Subsequently, on the same date, Mr. Michaelson accepted and, pursuant to the requirements of paragraph 7 of the Rules, returned, by email attachment to the Center, a fully executed Statement of Acceptance and Declaration of Impartiality and Independence. The Center, through an email letter dated August 6, 2010, notified the Parties of the appointment of Mr. Michaelson as sole Panelist. The Panel finds that it was properly constituted.

Based on the deadline set forth in paragraph 15 of the Rules, a decision is to be issued by the Panel before August 20, 2010.

This dispute concerns one domain name, specifically <americanmedicalsoftware.com>.

4. Factual Background

As indicated in the WhoIs registration record appearing in Annex A to the Complaint, the disputed domain name was registered on April 2, 2006 and will expire on April 2, 2011.

A. Complainant's AMERICAN MEDICAL SOFTWARE Marks

The Complainant owns two United States registrations for the mark AMERICAN MEDICAL SOFTWARE in block letters. The Complainant has provided, in Annex D to the Complaint, a copy of the registration certificates for these marks. Pertinent details of these two registrations are as follows:

1. AMERICAN MEDICAL SOFTWARE
United States Registration No. 1,439,638
registered May 12, 1987
renewed August 16, 2006

This mark is registered for use in connection with: "computer programs and program manuals, all sold as a unit" in international class 9. The registration indicates that both first use and first use in commerce of this mark, when used in conjunction with these goods, commenced at least as of January 31, 1986.

2. AMERICAN MEDICAL SOFTWARE
United States Registration No. 1,438,788
registered May 5, 1987
renewed August 19, 2006

This mark is registered for use in connection with: "providing custom software design, research and consulting services to others" in international class 42. The registration indicates that both first use and first use in commerce of this mark, when used in conjunction with these services, commenced at least as of February 7, 1986.

B. The parties and their activities

Over nearly the past 25 years, the Complainant has worked with and provided software products and services to thousands of medical professionals in large and small medical facilities across the United States. Some of the Complainant's products and services are evident at the Complainant's web site at <americanmedical.com> (a copy of the home page of which appears in Annex C to the Complaint). The Complainant's products and services include computer software related to medical practice management, medical billing, electronic claims, appointment scheduling, electronic medical records, hand-held technology custom software design consulting services and technical support services.

During that time, the Complainant has expended over USD 4 Million to advertise and promote its marks through, e.g., newsletters, its website, direct mail, email, print advertising, placement in trade journals and trade directories, customer presentations, attendance at trade shows and media attention.

The disputed domain name resolves to the Respondent's website which contains sponsored links to third-party commercial websites, including one labeled as "american medical". Whenever an Internet user were to click on that particular link, the user would be presented with a second page of links to various software websites, including those of various software companies. Other pages of the Respondent's website provided links to website of the Complainant's competitors. Copies of pertinent pages of the Respondent's website appear in Exhibits 1 and 2 to Annex F.

The Respondent has engaged in the same type of diversion involving several other third-party marks and which has been the subject of at least 20 prior ICANN decisions which resulted in transfer of the subject domain names. See, e.g., *Indiana SA v. Belize Domain Whois Service Lt*, WIPO Case No. D2009-0847 (August 17, 2009).

5. Parties' Contentions

A. Complainant

(i). Identical or Confusingly Similar

The Complainant contends that the disputed domain name is identical to the Complainant's AMERICAN MEDICAL SOFTWARE Marks simply because the name fully incorporated either of those marks.

Hence, the Complainant believes that it has satisfied the confusing similarity/identity requirement in paragraph 4(a)(i) of the Policy.

(ii). Rights or Legitimate Interests

The Complainant contends that the Respondent has no rights or legitimate interests in the disputed domain name pursuant to paragraph 4(a)(ii) of the Policy.

Specifically, the Respondent has not been authorized to use any of the Complainant's marks in a domain name or in any fashion. In spite of that, the Respondent, some 25 years after the Complainant registered its AMERICAN MEDICAL SOFTWARE Marks, registered the disputed domain name and is presently using it to divert Internet users, including Complainant's present and potential customers, through the Respondent's website and links contained in that site, to third-party websites, some of which offer goods and services that directly compete with those of the Complainant. By doing so, the Respondent is implying that it has a relationship with the Complainant, when, in fact, no such relationship or affiliation exists, and consequently is causing marketplace confusion which tarnishes the Complainant's marks and injures its reputation and is thus harmful to the Complainant.

(iii). Registered and Used in Bad Faith

Lastly, the Complainant contends that the Respondent registered and is now using the disputed domain name in bad faith under paragraph 4(a)(iii) of the Policy.

In particular, the Respondent registered the name and is intentionally using it, via the Respondent's website, to divert Internet users to third-party websites some of which offer goods and services that directly compete with those of the Complainant. This, in turn, is causing confusion to Internet users who reach the Respondent's website inasmuch as the Respondent is implying that it has a relationship with the Complainant, when, in fact, no such relationship or affiliation exists.

Furthermore, the Respondent has previously engaged in such conduct in several other instances unrelated to the present dispute, all of which resulted in transfer of the underlying domain names.

B. Respondent

The Respondent failed to file any Response to the contentions raised in the Complaint.

6. Discussion and Findings

In view of the lack of a Response filed by the Respondent as permitted under paragraph 5 of the Rules, this proceeding has proceeded by way of default. Hence, under paragraphs 5(e), 14(a) and 15(a) of the Rules, the Panel may in its discretion decide this administrative proceeding on the basis of the Complainant's undisputed factual representations.

A. Identical or Confusingly Similar

The Panel finds that the disputed domain name <americanmedicalsoftware.com> is identical to the Complainant's AMERICAN MEDICAL SOFTWARE Marks.

By simply comparing the disputed domain name to those marks, no doubt exists that the name, apart from having the generic top level domain (gTLD) “.com“ appended to the term “americanmedicalsoftware“, is identical to those marks. The addition of the gTLD is irrelevant in assessing confusing similarity or identity under paragraph 4(a) of the Policy and thus ignored.

Hence, the Complainant has satisfied its burden under paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

Based on the evidence of record here, the Panel finds that no basis exists which would appear to legitimize a claim by the Respondent, were it to have made one, to the disputed domain name under paragraph 4(c) of the Policy.

The Complainant has never authorized the Respondent to utilize its AMERICAN MEDICAL SOFTWARE Marks in conjunction with any of the products or services with which the Complainant uses those marks, nor does the Complainant apparently have any relationship, affiliation or association whatsoever with the Respondent. As such, any use to which the Respondent were to put the Complainant's marks or one confusingly similar thereto in connection with the identical or even similar goods and services to those currently provided by the Complainant, as recited in any of its trademark registrations, might likely violate the exclusive trademark rights now residing with the Complainant. See, e.g., *Varian Medical Systems Inc. v. Private*; WIPO Case No. D2010-0815 (July 19, 2010); *Gulf Craft Inc. Co. (LLC) v. PrivacyProtect.org / Domain, Stocker*, WIPO Case No. D2010-0504; *Clearwire Legacy, LLC v. Leon Ganesh*, WIPO Case No. D2010-0148; *Starline Publications, Inc. v. Unity*, WIPO Case No. D2008-1823; *GoDaddy.com, Inc., v. GoDaddysDomain.com, Clark Signs, Graham Clark*, WIPO Case No. D2007-0303; *Citgo Petroleum Corporation v. Richard Antinore*, WIPO Case No. D2006-1576; *New Destiny Internet Group, LLC and Xplor Media, Inc. v. SouthNetworks*, WIPO Case No. D2005-0884; *Pelmorex Communications Inc. v. weathernetwork*, WIPO Case No. D2004-0898; *Sybase, Inc. v. Analytical Systems*, WIPO Case No. D2004-0360; *Caesars World, Inc. and Park Place Entertainment Corporation v. Japan Nippon*, WIPO Case No. D2003-0615; *Leiner Health Services Corp. v. ESJ Nutritional Products*, NAF Claim No. 173362; *MPL Communications, Limited et al v. 1WebAddress.com*, NAF Claim No. 97092; *Treeforms, Inc. v. Cayne Industrial Sales, Corp.*, NAF Claim No. 95856; and *America Online, Inc. v. Xianfeng Fu*, WIPO Case No. D2000-1374. Consequently, in the Panel's view, the Respondent could not legitimately acquire any public association between it and either of the Complainant's AMERICAN MEDICAL SOFTWARE Marks or one similar thereto, and certainly not for the goods and services provided by the Complainant under those marks.

Further, there is absolutely no evidence of record that the Respondent has ever been commonly known by the disputed domain name. Nor could the Respondent in the Panel's view likely ever become commonly known by the name without likely infringing on the exclusive, long-held trademark rights of the Complainant. See, e.g., *Varian, Gulf Craft, Clearwire, Starline Publications* and *Treeforms, Inc.*, all cited *supra*.

Hence, based on the evidence before the Panel, the Respondent does not fall within paragraph 4(c)(ii) of the Policy.

Moreover, it is beyond any credible doubt to the Panel that the Respondent had actual knowledge of the Complainant's marks and the Complainant's exclusive rights in those marks at the time it registered the disputed domain name. Yet, in spite of that knowledge, it proceeded to register the name anyway and then intentionally use it as an instrument to divert Internet users to third-party websites, some of which described products or services directly competitive to those of the Complainant. The Panel infers, from the lack of any Response, that the Respondent's primary motivation in doing so was to create and then opportunistically exploit inevitable user confusion for the Respondent's own pecuniary benefit -- very possibly by eventually convincing the Complainant to purchase the disputed domain name from the Respondent at a substantial price in order to halt any further confusion and injury to the Complainant's marks and reputation. Inasmuch as such use is likely to directly infringe the Complainant's marks, it does not constitute a *bona fide* offering of goods or services, let alone one that occurred prior to receiving any notice of this dispute.

Consequently, the Respondent's conduct does not fall within paragraph 4(c)(i) or 4(c)(iii) of the Policy either.

C. Registered and Used in Bad Faith

The Panel finds that the Respondent's actions, with respect to the disputed domain name, constitute bad faith registration and use.

As noted above, the Panel infers that the Respondent was well aware of the Complainant's AMERICAN MEDICAL SOFTWARE Marks before the Respondent registered the name. Yet, in spite of that knowledge, the Respondent intentionally registered the name in an effort to opportunistically exploit the Complainant's reputation and goodwill in those marks to what most likely would have been the Complainant's detriment. This is rather evident in the Respondent's use of the name to address a website of links to third-party websites through which offerings were made for products and services directly competitive with those of the Complainant.

The Respondent, having effectively misappropriated the Complainant's goodwill and reputation in its marks, caused confusion in the mind of Internet users, who likely sought the Complainant's website, by falsely suggesting to those users that the Respondent had some type of an affiliation or relationship with the Complainant -- when in fact the Respondent did not. It stands to reason that the Respondent did so to ultimately cause injury to the Complainant through which the Respondent eventually stood to financially benefit. Most likely, after the Respondent had used the disputed domain name to cause sufficient confusion, it would have offered the name to the Complainant for sale at a price substantially in excess of its cost of registration -- a price which the Respondent then would have believed the Complainant might have been willing to pay if only to halt further injury to its marks and reputation. What prevented the Respondent from doing so was simply the Complainant's action in filing its Complaint to institute the present proceeding: an inference made by the Panel which is amply supported by the Respondent's failure to file any response.

Hence, the Panel concludes that the Respondent violated paragraph 4(a)(iii) of the Policy including specifically paragraphs 4(b)(i), and 4(b)(iv) thereof.

Thus, the Panel concludes that the Complainant has provided sufficient proof of its allegations, with respect to the disputed domain name, to establish a case under paragraph 4(a) of the Policy upon which the relief it now seeks can be granted.

7. Decision

Accordingly, under paragraphs 4(i) of the Policy and 15 of the Rules, the Panel grants the relief sought by the Complainant.

The disputed domain name, <americanmedicalsoftware.com>, is ordered transferred to the Complainant.

Peter L. Michaelson

Sole Panelist

Dated: August 20, 2010